



1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

3 Applicants: A.N. Schwartz et al. Attorney Docket No. SWTZ110464

4 Serial No: 08/794,154 Group Art Unit: 3408

5 Filed: February 3, 1997 Examiner: P. Nerbun *RECD 11/10/98*

6 Title: GOGGLES WITH PLIABLE AND RESILIENT SEALING PAD *AUG 14 1998 #24*

7 APPLICANTS' REPLY BRIEF

8 Seattle, Washington 98101

9 February 25, 1998

10 TO THE ASSISTANT COMMISSIONER FOR PATENTS:

11 NEW POINTS OF ARGUMENT IN EXAMINER'S ANSWER

12 1. The Examiner's Answer suggests, for the first time in this proceeding, that the
13 combination of Chen (U.S. Pat. No. 5,334,646) with Runckel (U.S. Pat. No. 5,331,691) or
14 Nishiyama (U.S. Pat. No. 5,093,940) would have been obvious "since Chen discloses that a
15 gelatinous elastomer is a known material and that it may be used in forming a large number of
16 articles including those designed for 'sport health care'" (emphasis added).

17 2. The Examiner's Answer mischaracterizes the teaching of Nishiyama (U.S. Pat.
18 No. 5,093,940).

19 RESPONSE TO NEW POINTS OF ARGUMENT

20 I. Sport Health Care Argument

21 The Examiner's Answer apparently agrees with Applicants that the principal issue in this
22 appeal is the following:

23 Would the teaching in Chen suggest, to a person skilled in the art, the use of Chen's
24 gelatinous elastomer as a replacement for the conformable pad described in Runckel
25 under 35 U.S.C. § 103?

1 In answering this question, the Examiner's Answer now relies principally upon the brief reference in
2 column 2, lines 7-9 of Chen that his gelatinous elastomer may be used for articles designed for "sport
3 health care."¹

4 The recently filed Examiner's Answer is the first time this language has been cited anywhere
5 in the prosecution of the present case or its parent case. The Examiner's first Office Action in the
6 parent application only asserted it would have been obvious to use the gelatinous elastomer of Chen
7 "since Chen states that gelatinous elastomers can be formed into any desired shape for use as a
8 cushion and possess elastic memory enabling articles to recover and retain their original shape after
9 many deformation cycles." *See* May 13, 1996, Office Action at page 3. There was not even a hint in
10 this first Office Action of the arguments that the Examiner now relies upon in claiming that the
11 substitution from Chen would have been obvious to a person skilled in the art.

12 Applicants responded to this first Office Action primarily by asking the Examiner to
13 reconsider the combination of Chen with the other prior art. *See* Amendment A filed August 16,
14 1996. The Examiner's November 1, 1996, final rejection denied Applicants' request for
15 reconsideration, adding the unwarranted contention that "one of the more obvious uses for a
16 gelatinous elastomer in an optical device would be as a seal adjacent to the wearer's face" Again,
17 there was no mention or even hint of the Examiner's reliance on the "sport health care"
18 language in Chen. *See* November 1, 1996, Office Action at page 5.

19 The March 26, 1997, final rejection in the present application simply contended that the
20 substitution would have been obvious "since Chen states that gelatinous elastomers may be used to
21 construct optical devices." The Examiner's new-found reliance on the brief reference to "sport health

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25 ¹ The Examiner's secondary argument that the combination of Runckel and Chen would have been obvious in
light of Chen's brief reference to "optical devices" is fully addressed on pages 8-11 of Appellants' Appeal Brief.
Pursuant to 37 C.F.R. § 1.193(b), Appellants will not restate their arguments as to such issue in this memorandum.

1 care" is asserted for the first time in the Examiner's Answer on appeal. None of the prior three
2 Office Actions made any reference to the "sport health care" language.

3 The Examiner's reliance on this language is clearly misplaced. First, Chen expressly
4 identifies the type of sport health care articles to which he is referring. These articles all relate to the
5 use of his material as a cushion, not as a seal, as is obvious from column 6, lines 48-58 of Chen,
6 where he describes the "medical and sport health care" articles with the following language:

7 The compositions are also useful as moulded shape articles for use in medical and
8 sport health care, such use [sic] include therapeutic hand exercising grips, dental
9 floss, crutch cushions, cervical pillows, bed wedge pillows, leg rest, neck cushion,
10 mattress, bed pads, elbow padding, dermal pads, wheelchair cushions, helmet liner,
11 cold and hot packs, exercise weight belts, traction pads and belts, cushions for splints,
12 slings, and braces (for the hand, wrist, finger, forearm, knee, leg, clavicle, shoulder,
13 foot, ankle, neck, back, rib, etc.), and also soles for orthopedic shoes.

14 This meaning of "sport health care" is further confirmed in column 6, line 67 through
15 column 7, line 17, where Chen further describes the medical and sport health care articles:

16 As an example of the versatility of use of the instant composition, a hand exerciser
17 can be made in any shape so long as it is suitable for use as a hand exerciser: a sphere
18 shape, a cube shape, a rectangular shape, etc. Likewise, a wheelchair cushion can be
19 made from the composition in any shape, so long as it meets the needs of the user of
20 the cushion. For example, a cushion can be made by forming the composition into a
21 selected shape matching the contours of the specific body part or body region. The
22 composition can be formed into any desired shaped [sic], size and thickness suitable
23 as a cushion; the shaped composition can be additionally surrounded with film, fabric,
24 foam, or any other desired material or combinations thereof. Moreover, the
25 composition can be casted onto such materials, provided such materials substantially
maintain their integrity (shape, appearance, texture, etc.) during the casting process.
The same applies for brace cushions for the hand, wrist, finger, forearm, knee, leg,
etc.

26 A person skilled in the art, reading Chen, would certainly conclude that the "sport health care"
27 articles referred to by Chen related to the use of his material as a cushion, and have nothing to do
28 with an airtight or watertight seal for goggles.

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1 Second, the invention claimed in the present application, as well as the disclosure of Runckel
2 and Nishiyama, relate primarily to devices for isolating the user's eyes from the outside environment.
3 They are not, in any normal sense of the phrase, "sport health care" devices. The dictionary
4 definition of the word "health" refers to the freedom from disease or ailment. In contrast, the
5 swimming goggles of Runckel and Nishiyama are primarily intended for the user's comfort while
6 swimming. Such goggles can be, and frequently are, used for swimming in fresh water and sea
7 water, neither of which poses any significant "sport health care" risk to the user. Likewise,
8 swimming pool water is often chlorinated, in part, to protect the user's eyes from water-born
9 pathogens. The amount of chlorination is carefully limited to avoid posing any health risk to the
10 user's unprotected eyes. Goggles are used in chlorinated water primarily to provide greater comfort
11 by preventing the mild eye irritation some people may experience from chlorinated water. The
12 Examiner's hindsight suggestion that goggles therefore are "sport health care" devices referred to by
13 Chen is an exceedingly strained and largely inaccurate interpretation of this phrase. Such a
14 diaphanous interpretation, and newly suggested teaching of Chen resulting therefrom, certainly
15 would not have been obvious to a person skilled in the art at the time Applicants' invention was
16 made.

17 Finally, and perhaps most telling, it is inconceivable that the Examiner would now suggest
18 that the "sport health care" language of Chen would render the combination with Runckel or
19 Nishiyama obvious when the Examiner himself cites this language for the very first time in his
20 Answer on appeal. Throughout the prosecution of this case and the parent case, the central issue has
21 been (and remains) whether it is obvious to combine Chen with either Runckel or Nishiyama. The
22 Examiner issued three Office Actions attempting to explain or justify such combination, and never
23 once referred to the "sport health care" language on which he now relies so heavily. Since the
24 Examiner is presumably a person skilled in the art, the Examiner's own repeated failure to cite such
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1 language is itself strong evidence that such language would not suggest the alleged combination to a
2 person skilled in the art.

3 **II. The Teaching of Nishiyama**

4 With respect to Claim 61, the Examiner contends that Nishiyama discloses a frame sized to
5 fit outside the orbits of the user's eyes based upon the following fallacious reasoning: (a) Runckel
6 discloses a sloping upper rim in order to fit comfortably within the user's eye orbit; and
7 (b) Nishiyama does not have a sloping upper rim. Obviously, the fact that Runckel believes that a
8 sloping upper rim allows the eye piece to fit comfortably does not mean that other eye pieces,
9 without a sloping upper rim, cannot also fit comfortably through the use of other techniques, such as
10 different padding or configuration. Moreover, even if Runckel believes that the sloping upper rim
11 claimed in his patent is necessary to comfortably fit within the orbits of the user's eyes, Runckel is
12 not necessarily right in this belief. Finally, Nishiyama may well fit within the orbits of the user's
13 eyes, but may not fit "comfortably" (at least as Runckel uses that term). Even a cursory comparison
14 of the drawings in Runckel and Nishiyama would disclose to a person skilled in the art that the eye
15 pieces in Nishiyama are sized to fit within the orbits of the user's eyes.

16 With respect to Claim 62, the fact that various elements in Nishiyama can be "rotated" does
17 not mean that the frame is "flexible" (i.e., it bends to any appreciable extent).

18 Claim 63 specifies that "the frame consists of a thin sheet of transparent material" (emphasis
19 added). Even a cursory review of Figure 1A in Nishiyama reveals that the frame (11, 12, 13) does
20 not consist of a sheet of material.

21 **CONCLUSION**

22 Pursuant to 37 C.F.R. § 1.193(b), Applicants have carefully limited their reply brief to new
23 points of argument raised in the Examiner's Answer. Although Applicants respectfully disagree with
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1 various other arguments made by the Examiner, Applicants are confident that the Board will
2 properly determine these issues and allow all claims pending in the present application.

3 Respectfully submitted,

4 CHRISTENSEN O'CONNOR
5 JOHNSON & KINDNESS^{PLLC}



6
7 Thomas D. Theisen
8 Registration No. 35,713
9 Direct Dial (206) 224-0721

10 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a
11 sealed envelope as first class mail with postage thereon fully prepaid addressed to: Assistant
12 Commissioner for Patents, Washington, D.C. 20231, on February 25, 1998.

13 Date: February 25, 1998



14 TDT:mjf/skg